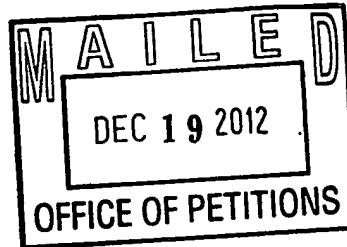




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In re Patent No. 6,444,109 : DECISION ON PETITION
Issue Date: 09/03/2002 : UNDER 37 CFR 1.183
Application Number: 09/698,370 :
Filing or 371(c) Date: 10/26/2000 :
Attorney Docket Number: 2156-056A :
:

This is also a decision on the "PETITION TO CORRECT INVENTORSHIP OF A PATENT," filed on October 11, 2012, which is treated as a petition requesting waiver under 37 CFR 1.183 of 1.324 inasmuch as it requires that a named inventor assent to the correction of the inventorship in an issued patent.

The petition is **DISMISSED**

Petitioner requests waiver of the rules in that named inventor Ronald Redline is deceased and is unavailable to execute the statement under § 1.324(b)(2). Petitioners assert that inventor Redline assigned all of his right, title, and interest in the patent, and requests that the Office accept a statement from the assignee in lieu of the statement from inventor Redline.

On December 12, 2012, petitioners additionally filed, *inter alia*, a Substitute Statement In Lieu of an Oath or Declaration for Utility or Design Patent Application (35 U.S.C. 115(d) AND 37 CFR 1.64) signed by John L. Cordani, Secretary of assignee MacDermid, Inc.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

Effective September 16, 2012, 37 CFR 1.324(b)¹ now states that:

Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

¹ See *Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act* 77 Fed. Reg. 48776, 48823 (August 14, 2012).

- (1) A statement from each person who is being added as an inventor and each person who is currently named as an inventor either agreeing to the change of inventorship or stating that he or she has no disagreement in regard to the requested change;
- (2) A statement from all assignees of the parties submitting a statement under paragraph (b)(1) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(c) of this chapter; and
- (3) The fee set forth in § 1.20(b).

Effective, September 16, 2012, 37 CFR 1.43² states that if an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent on behalf of the inventor.

At the outset, a Substitute Statement is not applicable to applications filed prior to September 16, 2012. The subject patent issued from Application No. 09/698,370, filed on October 26, 2000. Accordingly submission of a Substitute Statement is not appropriate.

Furthermore, assuming, *arguendo*, a Substitute Statement was appropriate in this application, the Substitute Statement filed with the renewed petition has been signed on behalf of the assignee. While § 1.324(b)(2) requires a statement from the assignee, § 1.324(b)(1) requires a statement from the person being added an inventor. As such, a statement from the assignee cannot satisfy the requirements of § 1.324(b)(1). Rather, this statement must be provided by the person being added as an inventor, or, as here, in the case of a deceased person, by the legal representative of the deceased person to be added as an inventor.

Therefore, petitioners must contact the legal representative of the person sought to be added as an inventor and request that they sign the statement in accordance with § 1.324(b)(1).

Although this application has issued as a patent, the principles of § 1.43 are relevant in that petitioner must identify the legal representative of the deceased inventor and obtain his or her signature on the statement in accordance with 37 CFR 1.324(b)(1). The statement should also identify the name of the legal representative.

As such, the petition is dismissed without prejudice to reconsideration pending submission of a statement under § 1.324(b)(1) signed by the legal representative of the deceased inventor.

² See Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act 77 Fed. Reg. 48776, 48815 (August 14, 2012).

If the legal representative cannot be found or refuses to sign the statement under § 1.324(b)(1), petitioners may proceed under 37 CFR 1.183. Petitioners must show diligent efforts to locate the legal representative.

37 CFR 1.42 states, in part:

In the case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

MPEP 409.01(a) states

One who has reason to believe that he or she will be appointed legal representative of a deceased inventor may apply for a patent as legal representative in accordance with 37 CFR 1.42.

Application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and the estate was under the sum required by state law for the appointment of an administrator. The heirs should identify themselves as the legal representative of the deceased inventor in the oath or declaration submitted pursuant to 37 CFR 1.63 and 1.64.

The showing of record is insufficient to show that a diligent effort was made to locate the legal representative. Where inability to find or located a named inventor(s), or legal representative thereof, is alleged, petitioners must demonstrate a thorough inspection of sources including, but not limited to, personnel or payroll records and probate filings. Petitioner should use diligent efforts, such as a national registry or Internet search, to determine the nearest living relative of the deceased inventor. Copies of the results of the search must be referred to in any renewed petition.³ Application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and the estate was under the sum required by law for the appointment of an administrator.⁴ The heirs should identify themselves as the legal representative of the deceased inventor in the statement submitted pursuant to § 1.324(b)(1).

Petitioners may show proof that a copy of the statement under § 1.324(b)(1) was sent or given to the non-signing inventors for review by providing a copy of the cover letter transmitting the statement under § 1.324(b)(1) to the legal representative or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the statement under § 1.324(b)(1) can be alleged, petitioners **must** show that a copy of the statement under § 1.324(b)(1) was sent or given to the legal representative. If the legal representative refuses in writing, petitioners must submit a copy

³ Id.

⁴ Id.

of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

If the statement under § 1.324(b)(1) is returned as undeliverable, petitioners should provide a copy of an envelope showing that a letter sent to the last known address of the legal representative was returned as undeliverable by the post office, or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

If repeated efforts to locate the legal representative are unsuccessful, petitioners will have shown that despite diligent efforts, the legal representative cannot be reached.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

A reply may also be filed via the EFS-Web system of the USPTO.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions